
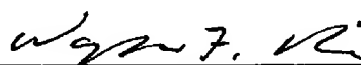


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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
I hereby certified that this correspondence is being transmitted by facsimile transmission to: Examiner Jonathan R. Adams, Group 2134, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450, Facsimile No. 571-273-8300, on August <u>16</u> , 2005.  Rosalind Q. Spiller	Application Number 09/745,863	Filed 12/21/2000	
	First Named Inventor LAMBERT, Howard S.		
	Art Unit 2134	Examiner Adams, Jonathan R.	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p style="text-align: right;">RECEIVED CENTRAL FAX CENTER AUG 16 2005</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>36,650</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p style="text-align: right;"> _____ Signature Wayne F. Reinke _____ Typed or printed name <u>518-452-5600</u> _____ Telephone number <u>August 16, 2005</u> _____ Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.</p> <p><input type="checkbox"/> *Total of _____ forms are submitted.</p>			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AP, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: Lambert et al. Confirmation No.: 2220
Serial No.: 09/745,863 Group Art Unit: 2134
Filed: 12/21/2000 Examiner: Adams, Jonathan R.
Title: A SECURITY MECHANISM PROVIDING ACCESS CONTROL FOR
LOCALLY-HELD DATA

CERTIFICATE OF FACSIMILE TRANSMISSION

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AUG 16 2005

I hereby certify that this correspondence is being transmitted by facsimile transmission to: Examiner Jonathan R. Adams, Group Art Unit 2134, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450, Facsimile No. 571-273-8300, on August 16, 2005.


Rosalind Q. Spiller

Date of Signature: August 16, 2005.

To: Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REMARKS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST

Dear Sir:

In response to a final Office Action with a mailing date of April 7, 2005, response to which was filed within two months of the final Office Action mailing date, and in light of an Advisory Action received with a mailing date of August 4, 2005, and the enclosed Combined Notice of Appeal from the Primary Examiner to the Board of Patent Appeals and Interferences & Petition for Extension Of Time and payment therefor, kindly consider the following remarks in support of the Pre-Appeal Brief Request for Review filed herewith.

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REMARKS35 U.S.C. §102 Rejection

The Office Action rejected claims 1, 4, 7 and 10-12 under 35 U.S.C. §102(b), as allegedly anticipated by Hasebe et al. (U.S. Patent No. 5,392,351). Applicants respectfully, but most strenuously, traverse this rejection.

As an initial matter, it appears the teaching of Hasebe et al. may have been misinterpreted. Hasebe et al. teaches a scenario whereby a vendor authorizes a particular storage medium for storing of encrypted software and all the information necessary, including a medium number, for a licensed user of the software to access the same. The storage medium is then sent to the licensed user. It is Applicants' understanding that no communication from the licensed user's computer to a server or other computer of the vendor is necessary for the licensed user to access the software. The point of the Hasebe et al. scheme is the addition of the medium number to ensure that an unauthorized third party cannot access the encrypted software. See Hasebe et al., for example, at column 8, lines 39-57.

Claim 1 recites, for example, "...data stored in an encoded form on a first data processing apparatus[.]" Against this aspect of claim 1, it is not at all clear what element in the Hasebe et al. scenario is being alleged to read on the first data processing apparatus. The final Office Action cites to column 7, line 19 of Hasebe et al. This section of Hasebe et al. describes the process of a user getting the plain text software from the encrypted software on the storage medium, and repeated access thereto. However, Applicants submit that a storage medium is not a data processing apparatus. Under any definition or interpretation for a "data processing apparatus," Applicants submit any such apparatus must be capable of actually processing data. Indeed, the examples in the present application are consistent. See, for example, FIG. 1 and the description thereof starting at page 12, line 9. Applicants submit that a storage medium merely stores data and does not process the data. Applicants submit that a storage medium would not be considered a data processing apparatus by one of ordinary skill in the art.

If the intent of the final Office Action was to cite the vendor's computer where the software presumably exists when the user initially orders it, Applicants submit there is no disclosure, teaching or suggestion that the program exists in an encoded form on the vendor's computer, only that it is encrypted for placement on the storage medium that is then sent to the user.

As another example, claim 1 recites sending a request from a decoding controller on the first data processing apparatus to a second data processing apparatus to determine attributes of a decoding process for accessing the encoded data.

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As noted above, the final Office Action fails to specifically identify an element in Hasebe et al. that reads on the claimed first data processing apparatus. According to the claim, the first data processing apparatus must also comprise a decoding controller. If the storage medium of Hasebe et al. web site intended to be cited against the claimed first data processing apparatus, then the comparison fails, as there is no decoding controller on the storage medium. If the vendor computer was intended to be cited against the claimed first data processing apparatus, then the comparison also fails. It is the vendor computer that does the encrypting, so it would have no need to request to determine attributes it already "knows." Further, it is clear from Hasebe et al. FIGs. 2 and 3, that it is the user computer that includes a decrypting unit. Expressly without commenting as to whether the Hasebe et al. decrypting unit reads on the claimed decoding controller, Applicants submit the decrypting unit is the only element therein that would make any sense to cite. Thus, following the comparison to its logical end, the user computer of Hasebe et al. would be the element cited against the claimed first data processing apparatus. However, that cannot be, of course, since the claim recites that the initial request from the requestor is for access to encoded data stored on the first data processing apparatus. In this case, the requestor is the user, and that comparison also fails.

Moreover, claim 1 recites that the request to determine attributes of the decoding process is sent from the decoding controller on the first data processing apparatus to a second data processing apparatus. Against this claim aspect, the final Office Action alleges that the "[m]edium number is loaded from software storage medium to vendor computer," citing Hasebe et al. at column 7, line 48, as well as FIGs. 3 and 7a. The quoted language from the final Office Action seems to indicate that the vendor computer is being cited against the claimed second data processing apparatus. However, Applicants submit that no attribute request from the storage medium is sent to the vendor computer. Indeed, it is the vendor in the Hasebe et al. scheme that initiates loading the attributes onto the storage medium when asked by the customer, and not a request from a decoding controller on the first data processing apparatus as claimed.

In addition, it is Applicants' position that the cited text section of Hasebe et al. (Col. 7, l. 48) merely describes the vendor setup of the storage medium *prior* to transfer to the user. In Hasebe et al., the storage medium with encrypted software thereon is transferred to the user, and the user's computer need not communicate with the vendor's computer (or any other computer) during decryption and accessing of the software. See, for example, column 8, lines 39-57 of Hasebe et al. describing decryption at the user computer, and clearly not requiring any communication with the vendor computer. Just because, for example, FIG. 3 of Hasebe et al. shows a block diagram

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including the vendor computer, the storage medium and the user computer, does not mean that they all communicate at the same time.

Thus, Applicants submit that Hasebe et al. fails to disclose, teach or suggest the above-noted aspect of claim 1. Further, since Hasebe et al. fails to disclose, teach or suggest the claimed request from the decoding controller on the first data processing apparatus to the second data processing apparatus, Applicants submit that Hasebe et al. also cannot disclose, teach or suggest doing anything in response to such a request, let alone receiving determined attributes at the decoding controller of the first data processing apparatus, as claimed.

Against the receiving aspect of claim 1, the final Office Action cites to the process of generating permission information at the vendor computer, and storing the same on the storage medium. However, Applicants are at a loss to understand where determined decoding process attributes are received at a decoding controller in the permission information generation process of Hasebe et al. The software storage medium has no decoding controller, and is not a data processing apparatus. Moreover, decrypting is done at the user computer, not the vendor computer; the vendor computer encrypts rather than decrypts.

Therefore, Applicants submit that claim 1 cannot be anticipated by, or made obvious over Hasebe et al.

Independent claims 10-12 contain limitations similar to those argued above with respect to claim 1. Thus, Applicants submit that the remarks made above with respect to claim 1 also apply to claims 10-12. Therefore, Applicants submit that claims 10-12 also cannot be anticipated by, or made obvious over Hasebe et al.

Applicants submit that the rejected dependent claims are allowable for the same reasons as the independent claims from which they directly or ultimately depend, as well as for their additional limitations.

For example, claim 4 recites that the determined attributes of a decoding process include identifiers of one or more of: a cryptor used in encryption and required for decryption, a compressor used in compression and required for decompression, and an authenticator for requestor authentication.

Against claim 4, the final Office Action again cites to Hasebe et al. at column 1, lines 46 and 47. However, the cited section of Hasebe et al. merely discloses encrypting a decrypting key. As set forth in the present specification at page 16, lines 17 and 18, the term "cryptor" is used to describe an encryption method/type, and not what the encryption is based on. The final Office

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Action commented that "an Internet search for the term 'cryptor' yields definitions including cryptographic keys." Indeed, the point here is that there is no one commonly understood meaning of "cryptor," hence use of the word "including" in the final Office Action quote. When there are multiple meanings for a term, it is standard construction to look to the specification for clarity. Moreover, Hasebe et al. fails to disclose, teach or suggest a compressor or an authenticator.

Therefore, Applicants submit that claim 4 cannot be anticipated by, or made obvious over Hasebe et al.

35 U.S.C. §103 Rejection

The final Office Action rejected claims 2, 3, 5, 6, 8, 9, 13 and 14 under 35 U.S.C. §103, as allegedly obvious over Hasebe et al. in view of various references.

However, while Applicants traverse these rejections, they involve dependent claims. Depending on the Decision of the Panel, the rejections may be moot. Moreover, given that remarks are limited to five pages, Applicants wanted the focus to be on the independent claims. Applicants expressly reserve the right, however, to submit substantive arguments regarding any or all of these rejections should this matter proceed to formal Appeal.

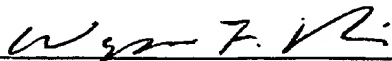
CONCLUSION

Applicants submit that the dependent claims not specifically addressed herein are allowable for the same reasons as the independent claims from which they directly or ultimately depend, as well as for their additional limitations.

For all the above reasons, Applicants maintain that the claims of the subject application define patentable subject matter and earnestly request allowance of claims 1-14.

If a telephone conference would be of assistance in advancing prosecution of the subject application, Applicants' undersigned attorney invites the Examiner to telephone him at the number provided.

Respectfully submitted,


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Dated: August 16, 2005.

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